REMARKS

No claims have been added or cancelled. Claim 1 is currently amended. Claims 1-14 are pending in the application.

The addition of "substituted aryl" as a Z group moiety is supported by the specification at page 11, lines 19-29; page 17, compound AM1172; and claim 7. The addition of "hydroxy substituted aryl" as a Z group moiety is supported by the specification at page 11, lines 19-29; page 17, compound AM1172; and claim 7.

The rejection of claim 8 under 35 U.S.C. §112, second paragraph.

Claim 8, and claims 9-14 depending therefrom, were rejected under 35 U.S.C. §112, second paragraph as allegedly having new matter introduced by applicant's amendment filed 7/31/2002.

Claim 8 as present on entry of this application into the U.S. national phase recited:

> 8. A compound represented by the following structural formula:
>
> X - Y - Z
>
> and physiologically acceptable salts thereof, wherein:
>
> X is a member selected from the group consisting of a hydrophobic aliphatic hydrocarbon chain containing from about 4 to about 30 carbon atoms and having one or more nonconjugated cis double bonds in the middle portion of the chain with a terminal radical selected from the group consisting of hydrogen, aryl and aryl substituted with a member selected from the group consisting of hydroxy, halogen, $-NO_2$, $-NH_2$, $-CH_3$, $-OCH_3$ and $-SCH_3$, or biphenyl or biphenyl having a terminal straight or branched alkyl group of about 1 to about 10 carbon atoms;
>
> Y is selected from the group consisting of hydrogen, -NH-C(O)-, -NH-, -NH-C(O)-NH-, -NH-C(O)O-, -C(O)-NH-, -O-C(O)-, -O- and -S-; and
>
> Z is selected from the group consisting of hydrogen, aryl, alkyl aryl, halogen substituted alkyl aryl, cyclic glycerols and substituted cyclic glycerols.

Thus, claim 8 prior to the amendment of July 31, 2002 encompassed compounds wherein:

> X is a member selected from the group consisting of a hydrophobic aliphatic hydrocarbon chain containing from about 4 to about 30 carbon atoms and having one or more nonconjugated cis double bonds in the middle portion of the chain with a terminal radical selected from the group consisting of hydrogen, aryl and aryl substituted with a member selected from the group consisting of hydroxy, halogen, $-NO_2$, $-NH_2$, $-CH_3$, $-OCH_3$ and $-SCH_3$, or biphenyl or biphenyl having a terminal straight or branched alkyl group of about 1 to about 10 carbon atoms;
>
> Y is selected from the group consisting of hydrogen, -NH-C(O)-, -NH-, -NH-C(O)-NH-, -NH-C(O)O-, -C(O)-NH-, -O-C(O)-, -O- and -S-; and
>
> Z is selected from the group consisting of aryl, alkyl aryl, halogen substituted alkyl aryl, cyclic glycerols and substituted cyclic glycerols.

For example, the compounds X-C(O)-NH-aryl; X-C(O)-NH-alkyl aryl; X-C(O)-NH-halogen substituted alkyl aryl; X-C(O)-NH-cyclic glycerol; and X-C(O)-NH-substituted cyclic glycerol are all fully supported by claim 8 as filed. None of the above compounds encompass the compound X-C(O)-NH-H. Expressed another way, claim 8 as entered encompassed numerous compounds wherein for any X, Z was not hydrogen when Y was C(O)-NH.

Additionally, the MPEP at section 2173.05(h)(I) lists Markush groups as a form of alternative limitations. The MPEP at section 2173.05(i), pp. 2100-208 states, with bolding added: "Any negative limitation or exclusionary proviso must have basis in the original disclosure. **If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims.**"

Applicant's specification, which includes claim 8, positively recited the possible alternative elements for this embodiment of the invention. Applicant's proviso excluding ONE combination of the positively recited elements is allowable under the instruction of MPEP §2173.05(i) and does not represent new matter.

Applicant's position is also supported by the court decisions that have allowed an applicant to claim a narrowed species within an originally claimed genus. See, for example, In re Wertheim, 191 USPQ 90, 97 (CCPA 1976), with italics in original: "That what appellants claim as patentable to them is *less* than what they describe as their

invention is not conclusive if their specification also reasonably describes that which they do claim. Inventions are constantly made which turn out not to be patentable, and applicants frequently discover during the course of prosecution that only a part of what they invented and originally claimed is patentable."

Applicant respectfully traverses this rejection and requests that it be withdrawn.

Claim 1 also explicitly disclosed moieties for X, Y and Z. Hydroxy substituted aryl was not explicitly listed in claim 1 but was explicitly listed in claim 7 which is dependent on claim 1. The present amendment to claim 1 reciting "wherein Z cannot be hydroxy substituted aryl if X has a hydrogen terminal radical and Y is -C(O)-NH-" is also supported for the above reasons.

The rejection of claims 1, 3 and 5-7 under 35 U.S.C. §102(a).

Claims 1, 3 and 5-7 were rejected under 35 U.S.C. §102(a) as having each and every feature and interrelationship anticipated by an abstract of the publication Potentiation Of Anandamide Hypotension By The Transport Inhibitor AM404, European Journal of Pharmacology, Oct. 15, 1997, 337 (1) R1-2 of A. Calignano et al. As stated in this rejection: "AM404, meets the compound of instant claims 1, 3, and 5-7 when X is has (sic) a terminal radical of a hydrogen, Y is a carbonyl amine radical, and Z is a hydroxy substituted aryl group."

The method of claim 1 no longer claims use of a compound wherein X has a hydrogen terminal radical, Y is -C(O)-NH- and Z is a hydroxy substituted aryl group is no longer possible. Claims 1, 3 and 5-7 are no longer anticipated by this cited reference and are therefore patentable.

Claims 1, 3 and 5-7 were also rejected under 35 U.S.C. §102(a) as having each and every feature and interrelationship anticipated by the publication Functional Role Of High-Affinity Anandamide Transport As Revealed By Selective Inhibition, Science.

August 22, 1997 (227 (5329) 1094-7 by Beltramo et al. As stated in this rejection: "AM404, meets the compound of instant claims 1, 3, and 5-7 when X is has (sic) a terminal radical of a hydrogen, Y is a carbonyl amine radical, and Z is a hydroxy substituted aryl group."

The method of claim 1 no longer claims use of a compound wherein X has a hydrogen terminal radical, Y is -C(O)-NH- and Z is a hydroxy substituted aryl group is no longer possible. Claims 1, 3 and 5-7 are no longer anticipated by this cited reference and are therefore patentable.

The alleged double patenting rejection over U.S. application no. 09/328,742.

Claims 1-7 of the present application were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 and 12-19 of copending application no. 09/328,742. In making this rejection the Office Action admits claims 1-14 of the present application "are not identical" to the recited claims of copending application no. 09/328,742.

Applicants note that the Office communication admits that this is only a "provisional" rejection as no claims have in fact been patented.

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In summary, Applicants have addressed each of the objections and rejections within the present Office Action. It is believed the application now stands in condition for allowance, and prompt favorable action thereon is respectfully solicited.

The Examiner is invited to telephone Applicant(s)' attorney if it is deemed that a telephone conversation will hasten prosecution of this application.

Respectfully submitted,

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